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Jay S. Walker

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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/787,356
Filing Date: February 26, 2004
Appellant(s): WALKER ET AL.

Jerome A. DeLuca, Esq.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/28/2008 appealing from the Office action mailed 09/28/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

1. The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

2. New grounds of rejection to be reviewed on appeal:

Claims 1-4, 8, 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seelig et al. (US 5,997,400) in view of Muzaffar et al. (GB 2,372,218 A) and Okada (US 4700948).

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seelig et al. in view of Muzaffar et al and Okada., and further in view of Walker et al. (US 2001/0031654).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seelig et al. in view of Muzaffar et al and Okada., and further in view of Hedrick et al. (US 6,368,216).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US Patent Application No.

2002/0016200	Baerlocher et al	2-2002
US Patent No. 6,733,389	Webb et al	5-2004
US Patent No. 6,602,136	Baerlocher et al	8-2003
US Patent No. 5,997,400	Seelig et al	12-1999
UK Patent No. 2,372,218	Muzaffar et al	8-2002
US Patent Application No.		
2001/0031654	Walker et al	10-2001
US Patent No. 6,368,216	Hedrick et al	4-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 13 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Baerlocher et al. (US 2002/0016200, herein Baerlocher '200).

Re claim 13: Baerlocher '200 discloses a method comprising: initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls (Para. [0067]-[0068]); determining a first situation the secondary game (initialization of path and location of the game character 58b), in which the first situation includes a first plurality of locations (56b, Fig. 11) that may be occupied by a game character (58b, Fig. 11), in which the first situation includes a first set of connections among the first plurality of locations, and in which at least one of the first plurality of locations confers an advantage (i.e. bonus amount of location 56b) to a player if occupied by the game character (as depicted in Fig. 11; Para. [0067]-[0069]);

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determining a first outcome (i.e. the game character 58b moving a certain number of spaces; Para. [0067]); and determining a second situation of the secondary game (second location of game character 58b), in which the second situation includes a second plurality of locations (56b) that may be occupied by the game character, in which the second situation includes a second set of connections among the second plurality of locations, and in which at least one of the second plurality of locations confers an advantage (i.e. bonus amount of location 56b) to the player if occupied by the game character (Fig. 11; Para. [0067]-[0069]); wherein there is at least one difference between at least one of the first plurality of locations of the first situation as compared to the second plurality of locations of the second situation (second location of game character 58b is different from the first location of game character 58b, no two locations where the character can be located are the same), and the first set of connections of the first situation as compared to the second set of connections of the second situation (the connections of game character 58b change as the game character moves from one location to the next). With respect to applicant's "handle pulls", Baerlocher discloses a play button (20) which serves the same function as pulling a handle (18) of the gaming machine (Fig. 1; Para. [0035]), and is considered to be an equivalent.

Re claim 17: Baerlocher '200 discloses a method comprising: initiating a secondary game at a gaming device, in which the course of the secondary game

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depends on outcomes of two or more handle pulls (Para. [0067]-[0068]); determining a first situation of the secondary game (initialization of path and location of the game character 58b), in which the first situation includes an objective within the secondary game (reaching the “starting” location 56b after a number of laps) and a first prize amount (i.e. bonus amount of location 56b) associated with the objective; determining a first outcome (i.e. the game character 58b moving a certain number of spaces; Para. [0067]); and determining, based on the first situation and the first outcome, a second situation, in which the second situation includes the objective and a second prize amount (i.e. bonus amount of location 56b) associated with the objective (Fig. 11; Para. [0067]-[0069]). See claim 13 above regarding applicant’s “handle pulls”.

Baerlocher ‘200 further discloses the following:

Re claim 18: determining a second situation includes determining, based on the first situation and the first outcome, a second situation, in which the second situation includes the objective and a second prize amount associated with the objective, and in which the second prize amount is different from the first prize amount (different bonus values of the various locations on the path 54b, Fig. 11).

Re claim 19: determining a first situation includes determining a first situation of the secondary game, in which the first situation includes an objective for a game

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character (58b) to reach a particular square on a game board (reaching the “starting” location 56b after a number of laps), and in which the first situation includes a first prize amount associated with the objective (Fig. 11; Para. [0067]-[0069]).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 11-12 are rejected under 35 U.S.C. 102 (e) as being anticipated by Webb et al. (US 6,733,389).

Re claim 11: Webb discloses a method comprising: initiating a secondary game (204) at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls (Col. 10, lines 63-67, Col. 11, lines 7-16); determining a first situation of the secondary game, in which the first situation includes a first number of handle pulls (as represented by 212, Fig. 9B) available for completing the secondary game (as depicted in Fig. 9B); determining a first outcome (as represented by the symbols on the reels 34, Fig. 9B); and determining based on the first game situation and the first outcome, a

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second game situation, in which the second game situation includes a second number of handle pulls (as represented by 212, Fig. 9C) available for completing the secondary game (as depicted in Fig. 9B) (Col. 11, lines 7-40).

Re claim 12: Webb further discloses that the second number of handle pulls (as represented by 212, Fig. 9D) is less than one less than the first number of handle pulls and greater than one (as represented by 212, Fig. 9B) (Col. 12, lines 28-49).

7. Claims 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Baerlocher et al. (US 6,602,136, herein Baerlocher '136).

Re claim 13: Baerlocher '136 discloses a method comprising: initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls (Col. 8, lines 55-60); determining a first situation the secondary game (initialization of paths 54 and location of the symbol marker 58), in which the first situation includes a first plurality of locations (66, Fig. 10) that may be occupied by a game character (58, Fig. 10), in which the first situation includes a first set of connections among the first plurality of locations, and in which at least one of the first plurality of locations confers an advantage (i.e. bonus amount of location 66) to a player if occupied by the game character (as depicted in Fig. 10); determining a first outcome (i.e.

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the symbol marker 58 moving a certain number of spaces); and determining a second situation of the secondary game (second location of symbol marker 58), in which the second situation includes a second plurality of locations (66, of middle path 54) that may be occupied by the game character, in which the second situation includes a second set of connections among the second plurality of locations, and in which at least one of the second plurality of locations confers an advantage (i.e. bonus amount of location 66) to the player if occupied by the game character (Fig. 10) (Col. 8, lines 14-67; Col. 9, lines 1-22); wherein there is at least one difference between at least one of the first plurality of locations of the first situation as compared to the second plurality of locations of the second situation (second location of symbol marker 58 is different from the first location of symbol marker 58, no two locations where the marker can be located are the same between the two locations), and the first set of connections of the first situation as compared to the second set of connections of the second situation (the connections of symbol marker 58 change as the symbol marker moves from one location to the next). With respect to applicant's "handle pulls", Baerlocher discloses a play button (20), which serves the same function as pulling a handle (18) of the gaming machine (Fig. 1; Col. 4, lines 43-47), and is considered to be an equivalent.

Baerlocher '136 further discloses the following:

Re claim 14: the second situation includes a second set of connections among the second plurality of locations (as represented by the middle path 54 of Fig. 10), the second set of connections differing from the first set of connections (as represented by the lower path 54 of Fig. 10).

Re claim 15: the second situation includes a second plurality of locations that may be occupied by a game character (as represented by the middle path 54 of Fig. 10), the second plurality of locations differing from the first plurality of locations (as represented by the lower path 54 of Fig. 10).

Re claim 16: the second situation includes a second plurality of locations that may be occupied by a game character (as represented by the middle path 54 of Fig. 10), the first plurality of locations including one location not included in the second plurality of locations (as represented by the lower path 54 of Fig. 10, the lower path having more locations 66).

Re claim 17: Baerlocher '136 discloses a method comprising: initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls (Col. 8, lines 55-60); determining a first situation of the secondary game (initialization of paths 54 and

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location of the symbol marker 58), in which the first situation includes an objective (collecting a certain amount of accumulation symbols 60) and a first prize amount (i.e. bonus amount of location 66) associated with the objective; determining a first outcome (i.e. the symbol marker 58 moving a certain number of spaces); and determining, based on the first situation and the first outcome, a second situation (second location of symbol marker 58), in which the second situation includes the objective and a second prize amount (i.e. bonus amount of location 66) associated with the objective (Fig. 10; Col. 8, lines 14-67; Col. 9, lines 1-22).

Baerlocher '136 further discloses the following:

Re claim 18: determining a second situation includes determining, based on the first situation and the first outcome, a second situation, in which the second situation includes the objective and a second prize amount associated with the objective, and in which the second prize amount is different from the first prize amount (different bonus values of the various locations 66 on the paths 54, Fig. 10).

Re claim 19: determining a first situation includes determining a first situation of the secondary game, in which the first situation includes an objective for a game character (58) to reach a particular square on a game board (reaching the

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“collect” or “?” location of the upper path 54), and in which the first situation includes a first prize amount associated with the objective (Fig. 10; Col. 8, lines 14-67; Col. 9, lines 1-22).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher '200 in view of Hedrick et al. (US 6,368,216). The teachings of Baerlocher have been discussed above.

However, Baerlocher '200 fails to disclose that the first situation includes an objective for a player to obtain a certain number of symbols on the reels of the gaming device over the course of multiple spins, and includes a first prize amount associated with the objective.

Hedrick teaches a gaming machine with a method of conducting a secondary game that awards the player with a bonus for accumulating a certain number of symbols (1217) on the reels (220) of the gaming machine over multiple spins (Fig. 12A-12B; Col. 21-22, lines 32-5).

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Baerlocher and Hedrick are considered to be analogous art because both inventions are from the same field of endeavor of gaming devices having secondary games.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the method for play of a secondary game of Baerlocher with the symbol collection game of Hedrick in order to increase the player's enjoyment and excitement (Baerlocher '200, Para. [0006]). Thus, it would have been obvious to combine Baerlocher with Hedrick to obtain the invention as specified in claim 20.

10. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Webb et al. (US 6,733,389) in view of Seelig et al. (US 5,997,400). The teachings of Webb et al. have been discussed above.

However, Webb fails to disclose receiving a prepayment for the two or more handle pulls prior to the initiation of the secondary game, wherein the prepayment is distinct from an addition of credits to a balance of credits available for wagering on a primary game.

Seelig discloses receiving a prepayment for the two or more handle pulls prior to the initiation of the secondary game, wherein the prepayment is distinct from an addition of credits to a balance of credits available for wagering on a primary game (Col. 3, Lines 24-38).

Seelig and Webb are considered to be analogous art because both inventions are from the same field of endeavor of gaming devices having secondary games. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to integrate the teachings of Seelig into the teachings of Webb in order to increase the use of the slot machine and therefore increase profits for the casino. Thus, it would have been obvious to combine Webb with Seelig to obtain the invention as specified in claim 22.

11. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al. (US 6,602,136, herein Baerlocher '136) in view of Seelig et al. (US 5,997,400). The teachings of Baerlocher et al. have been discussed above.

However, Baerlocher fails to disclose receiving a prepayment for the two or more handle pulls prior to the initiation of the secondary game, wherein the prepayment is distinct from an addition of credits to a balance of credits available for wagering on a primary game.

Seelig discloses receiving a prepayment for the two or more handle pulls prior to the initiation of the secondary game, wherein the prepayment is distinct from an addition of credits to a balance of credits available for wagering on a primary game (Col. 3, Lines 24-38).

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Seelig and Baerlocher are considered to be analogous art because both inventions are from the same field of endeavor of gaming devices having secondary games.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to integrate the teachings of Seelig into the teachings of Baerlocher in order to increase the use of the slot machine and therefore increase profits for the casino. Thus, it would have been obvious to combine Baerlocher with Seelig to obtain the invention as specified in claims 23-24.

New Grounds of Rejection:

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-4, 8, 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seelig et al. (US 5,997,400) in view of Muzaffar et al. (GB 2,372,218 A) and Okada (US 4700948).

Re claim 1: Seelig discloses a method comprising: initiating a secondary game (the racing horse game as depicted in Fig. 1) at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls

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(Col. 3, lines 24-37); determining at a first time a first situation of the secondary game (the initial position of the racing element 22), in which the first situation includes a first amount of time (as represented by the timer display 24) available for completing the secondary game; determining a first outcome (the indicia displayed on the wheels 18) (Col. 3, lines 38-44); determining, at a second time, based on the first game situation and the first outcome, a second game situation (a subsequent position of the racing element 22), in which the second game situation includes a second amount of time (as represented by the timer display 24) available for completing the secondary game (Fig. 1; Col. 3-4, lines 62-13). However, Seelig fails to disclose that the first outcome is based on a random number generator; or that the difference between the first amount of time and the second amount of time is greater than the elapsed time between the first time and the second time.

Okada discloses that a first outcome is based on a random number generator (Col. 3, Lines 52-64).

Muzaffar teaches a spot-the-difference type game in which a timer is provided that limits the amount of time a player has to respond, and further that the player may lose time for an inaccurate response (Pg. 5, lines 14-16; Pg. 6, lines 22-24). Additional time may be subtracted from the remaining time providing the player with less time than has simply elapsed, and as such, the difference between the first amount of the time (before one selection) and the second amount of time

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(before another selection and following an inaccurate response at the first time) may be greater than the elapsed time.

Seelig and Muzaffar are considered to be analogous art because both inventions are from the same field of endeavor of time-based games.

Seelig and Okada are considered to be analogous art because both inventions are from the same field of endeavor of reel-based games.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the secondary game of Seelig with the time reduction method of Muzaffar and the random number generation method of Okada in order to encourage slot players to continue playing and to entertain both the players themselves and others who may be watching (Seelig, Col. 1-2, lines 66-4). Thus, it would have been obvious to combine Seelig with Muzaffar to obtain the invention as specified in claims 1, and 8 and 10, as follows.

Seelig further discloses the following:

Re claim 8: that determining a first situation includes determining at a first time a first situation of the secondary game, in which the first situation includes a first amount of time available for a game character (22) to reach a destination (the Win/Finish line, as depicted in Fig. 1) in the secondary game (Col. 3-4, lines 66-13).

Re claim 10: that determining the first outcome includes: receiving an initiation signal from a player (pulling the lever 14) (Col. 3, lines 24-44); generating a random number; determining an outcome associated with the random number, in which the outcome comprises a set of symbols (Col. 3, lines 38-44), although Seelig does not specifically disclose the use of a random number to generate the outcome, it is very well known in the art to utilize a random number generator to generate outcomes in reel-type slot machines as disclosed above in Okada (Col. 3, Lines 52-64); spinning a set of reels of the gaming device (Col. 3, lines 38-44); and stopping the reels such that the set of symbols are visible to the player (as depicted in Fig. 1).

Re claim 2: Seelig fails to disclose determining a reduction of time associated with the first outcome.

Muzaffar teaches reducing the time associated with an inaccurate response (the outcome of the selection made by the player) (Pg. 6, lines 22-24).

Seelig and Muzaffar are considered to be analogous art as provided above.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the secondary game of Seelig with the outcome based time reduction of Muzaffar in order to make the game more

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challenging to the player. Thus, it would have been obvious to combine Seelig with Muzaffar to obtain the invention as specified in claims 2 and 3-4, as follow.

Re claim 3: Seelig further discloses determining, at a second time, based on the first game situation (the initial position of the racing element 22) and the reduction of time, a second game situation (a subsequent position of the racing element 22), in which the second game situation includes a second amount of time available for completing the secondary game (as represented by the timer display 24 which is counting down) (Col. 3, lines 62-66).

Re claim 4: Seelig fails to disclose that the difference between the first amount of time and the second amount of time is equal to the sum of the reduction of time and the elapsed time between the first and the second time.

Muzaffar teaches a game that has a timer and that a player may lose additional time for an inaccurate response as described above, and further is considered to be capable of providing for the difference between the first and second amounts of time to be equal to the sum of the reduction (for the inaccurate response) and the elapsed time between responses.

Re claim 21: Seelig further discloses receiving a prepayment for the two or more handle pulls prior to the initiation of the secondary game, wherein the

prepayment is distinct from an addition of credits to a balance of credits available for wagering on a primary game (Col. 3, Lines 24-38).

14. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seelig et al. in view of Muzaffar et al and Okada., and further in view of Walker et al. (US 2001/0031654). The teachings of Seelig, Muzaffar and Okada have been discussed above.

Re claim 5: However, Seelig as modified by Muzaffar fails to disclose that the first situation includes a first amount of time available for completing a first number of handle pulls.

Walker teaches a method of automatically playing a gaming machine based on certain criteria such as the number of pulls (Para. [0075]; equivalent to applicant's "first number of handle pulls") to be played between a starting time (4462)) and ending time (4463; the difference between start and end time being equivalent to applicant's "first amount of time") (Fig. 5; Para. [0059], [0072], [0084] and [0101]).

Re claim 6: However, Seelig as modified by Muzaffar fails to disclose that the second game situation includes a second amount of time available for completing a second number of handle pulls.

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Walker teaches that the gaming device increases the number of pulls that have occurred (Para. [0090]; the new stored value being equivalent to applicant's "second number of handle pulls") after a round of play and uses a clock (412) of a network server (4) to determine if play should continue (Fig. 3; Para. [0084]). In using the internal clock to determine if play should be continued (i.e. is there time remaining), the system is considered to be capable of determining an amount of time remaining by subtracting the current time of clock 412 from the end time 4463, which is equivalent to applicant's "second amount of time".

Re claim 7: However, Seelig as modified by Muzaffar fails to disclose that the second number of handle pulls is one less than the first number of pulls.

Walker teaches that the stored value of number of pulls is increased by one after each round as discussed above. In as much as the stored number of pulls could be implemented as a "remaining pulls" value by subtracting the current number of pulls from the maximum number of pulls 4464, the second number of pulls would be one less than the first number of pulls after each subsequent round using a remaining pulls variable.

Seelig as modified by Muzaffar and Walker are considered to be analogous art because both inventions are from the same field of endeavor of slot-type gaming devices.

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Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the time-based secondary game of Seelig as modified by Muzaffar with the handle pull- and time-limited game of Walker in order to increase the play of the machine and the revenue for the casino. Thus, it would have been obvious to combine Seelig as modified by Muzaffar with Walker to obtain the invention as specified in claims 5-7.

15. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seelig et al. in view of Muzaffar et al and Okada., and further in view of Hedrick et al. (US 6,368,216). The teachings of Seelig and Muzaffar and Okada have been discussed above.

However, Seelig as modified by Muzaffar fails to disclose that determining a first situation, in which the first situation includes a first amount of time available to obtain a target number of game indicia.

Hedrick teaches a method of playing a secondary game in which the object is to obtain a certain number of symbols (1217) (Fig. 12A; Col. 21, lines 32-45).

Seelig as modified by Muzaffar and Hedrick are considered to be analogous art because both inventions are from the same field of endeavor of gaming devices having secondary games.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the time-based secondary game of

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Seelig as modified by Muzaffar with the symbol collection game of Hedrick in order to encourage slot players to continue playing and to entertain both the players themselves and others who may be watching (Seelig, Col. 1-2, lines 66-4). Thus, it would have been obvious to combine Seelig as modified by Muzaffar with Hedrick to obtain the invention as specified in claim 9.

(10) Response to Argument

Appellants argue that Baerlocher '200 fails to teach or suggest "initiating a secondary game at a gaming device, in which the course of the secondary game depends on outcomes of two or more handle pulls".

The Examiner disagrees with this suggestion and argument for the following reasons: Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "handle pull" in claims 1, 11, 13 and 17 is used by the claim to mean "a complete primary game at a gaming device, involving the placement of a wager, the determination of an at least partially random or pseudo-random outcome, the determination of a payment amount and the providing or crediting of a player with the payment amount", while the accepted meaning is "the activation of a

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gaming device to produce an outcome.” The term is indefinite because the specification does not clearly redefine the term. Hence, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a handle pull referring to a complete primary game at a gaming device) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellants further contend that Baerlocher '200 fails to teach or suggest “wherein there is at least one difference between at least one of: the first plurality of locations of the first situation as compared to the second plurality of locations of the second situation and the first set of connections of the first situation as compared to the second of connections of the second situation.”.

The Examiner disagrees with this suggestion and argument for the following reasons: the location of game character (Baerlocher '200, Fig. 8, reference character 58b) as it moves from a first of a plurality of locations (Baerlocher '200, Fig. 8, reference character 56a) to a second of the plurality of locations (Baerlocher '200, Fig. 8, reference character 56a) the value displayed on the two different locations varies as the character moves along the course, therefore there is a difference between a first location as compared to a second location.

Appellants further contend that Webb '389 does not disclose that "the second number of handle pulls is (i) less than one less than the first number of handle pulls and (ii) greater than one".

Examiner disagrees with this suggestion and argument for the following reasons: as seen in Fig. 9D, reference character 212, the number of handle pulls is "7", is less than one less than the first number of handle pulls as seen in Fig. 9B, reference character 212, in which the number of handle pulls is "9".

Appellants further contend and challenge the Examiner's OFFICIAL NOTICE that random number generators are well known to be used in the art to generate random outcomes. Therefore, the Examiner has introduced the Okada reference and the new grounds of rejections disclosed above to provide a prior art reference which uses the well known method of utilizing a random number generator to produce outcomes.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer

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exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

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A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/KAREN M. YOUNG/

Director, Technology Center 3700

Respectfully submitted,

/Jason Pinheiro/

Examiner, Art Unit 3714

Conferees:

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3714

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711